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AMENDMENTS TO THE DRAWINGS

The attached drawings include changes to FIGS. 2-5. The sheets containing FIGS. 2-5 replace the original sheets including FIGS. 2-5

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REMARKS

Applicant requests reconsideration and allowance of the present application in view of the foregoing amendments and the following remarks.

Claims 1-7 are pending in the present application. Claims 1, 6 and 7 are the independent claims.

In accordance with the foregoing, the abstract, drawings 2-5 and claims 1, 3, 6, 7 have been amended. Support for the amendments to claims 1, 6 and 7 can be found throughout the originally filed Specification, for example, at pages 6-18. No new matter is being added.

At page 4, the Office Action objected to the Abstract because the abstract exceeded 150 words. The Abstract has been amended to include 150 words or fewer and to remove the "means" terminology. Accordingly, favorable consideration is requested.

At page 4, the Office Action objected to the Specification, stating that that the status of all parent priority applications must be updated in the first line of the specification, and near all citations where appropriate. Applicant respectfully submits that there has been no status change of the corresponding Japanese application, and therefore no updates are appropriate at this time. Favorable consideration is respectfully requested.

In the Office Action on page 3, at items 8-9, Figures 2-5 were objected to because they did not include lead lines. In order to overcome these objections, replacement figures are submitted herewith. In FIGS. 2-5, lead lines have been added for each character reference to indicate which surface they correspond with. For the convenience of the Examiner, an annotated sheet showing the changes made is attached. Favorable consideration of the Drawings is respectfully requested.

Claim Rejections Under 35 U.S.C. §112

At page 5 of the Office Action, numbered item 13, claims 1-5 were rejected under 35 U.S.C. §112, second paragraph, for indefiniteness. The Examiner contends that claim 1 contains the indefinite language, consisting of the phrase "such as." Applicant respectfully submits that no such claim language exists in claim 1. After carefully reviewing the claims, Applicant located the phrase "such as" only in claim 3, and claim 3 has been amended to remove the phrase "such as". Applicant respectfully requests favorable reconsideration and withdrawal of the rejection.

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Claim Rejections Under 35 U.S.C. §102

On Page 5-9 of the Office Action, claims 1-4, 6 and 7 were rejected under 35 U.S.C. §102 for being anticipated by U.S. Patent No. 5,146,552 to Cassorla et al. All rejections are respectfully traversed.

Independent claim 1 recites a document browser that merges and displays additional information with document data, including text data and/or image data, that can be displayed on a display device. The document browser recited in independent claim 1 includes:

- additional information receiving means for receiving input of the additional information that includes handwritten pen-track data;

- browsing means for merging and displaying on the display device the document data with the additional information that includes handwritten pen-track data;

- positional information obtaining means for obtaining the positional information of the additional information in the document data;

- properties information obtaining means for obtaining properties information of the additional information;

- additional information storage means for storing the additional information that includes handwritten pen-track data with the positional information and the properties information;

- additional information searching means for searching the additional information stored in the additional information storage means based on the properties information of the additional information; and

- search results display means for displaying on the display device the search results found by the additional information searching means.

Applicant respectfully submits that Cassorla et al. does not teach at least the aforementioned features of the independent claims.

Cassorla et al. discusses a configuration in which a writer or an editor of an electronic document adds marks so that document elements such as chapter, section, subsection, paragraph and drawings can be identified. It also discusses a configuration in which a reader can add a pinpoint annotation at a specific line or word. More specifically, a user can specify where in a document to insert a bookmark and/or highlight by specifying a position to insert using a pointing device such as a mouse. Further, it discloses that the line number, writer identification, date information and the like are added to a text and are stored in a file or partition of a file on a host system. See Cassorla et al. Abstract.

Applicant respectfully submits that, in Cassorla et al., the information stored through the pinpoint annotation feature along with the position information of the annotations is not information displayed on the electronic document. Moreover, according to Cassorla et al., it only stores information on the date of the annotations or the person who inserted the annotation.

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In contrast to the teachings of Cassorla et al., the amended independent claim 1 recites, in relevant part, "additional information receiving means for receiving input of the additional information that includes handwritten pen-track data", "browsing means for merging and displaying on the display device the document data with the additional information that includes handwritten pen-track data", and "additional information storage means for storing the additional information that includes handwritten pen-track data with the positional information and the properties information". As Cassorla et al. fails to teach or suggest at least these features of amended independent claim 1, Applicant respectfully submits that Cassorla et al. fails to teach or suggest all of the features of amended independent claim 1. Thus, Applicant respectfully submits that amended independent claim 1, and those claims depending directly or indirectly therefrom, patentably distinguish over the prior art and are, therefore, in condition for allowance.

Amended independent claim 6 is directed to a method having features similar to those of amended independent claim 1. Therefore, Applicant respectfully submits that claim 6 patentably distinguishes over the Cassorla et al. for reasons similar to independent currently amended claim 1. Likewise, independent currently amended claim 7 is directed to a computer readable storage medium and recites features similar to those of claim 1. Accordingly, Applicant respectfully submits that amended independent claim 7 patentably distinguishes over the prior art for reasons similar to claim 1 and is, therefore, in condition for allowance.

Accordingly, favorable reconsideration and withdrawal of the rejection of independent claims 1, 6 and 7, and those claims depending directly or indirectly therefrom, are respectfully requested.

Claim Rejections Under 35 U.S.C. §103(a)

At page 10 of the Office Action, the Examiner contends that claim 5 is rejected under 35 U.S.C. §103(a) as being unpatentable over Cassorla et al. in further view of Fitzpatrick et al., "Translucent Window Attribute," IBM Technical Disclosure Bulletin, Vol. 36, No. 06A, pages 135-136, June 1, 1993.

Fitzpatrick et al. is directed to a translucent window attribute, which enables users to access objects located "below" windows possessing this attribute. Fitzpatrick et al., however, does not cure the deficiencies of Cassorla et al. noted above.

Claim 5 depends directly from claim 1 and includes all of the features of that claim. As Fitzpatrick et al. fails to cure the deficiencies of Cassorla et al., Cassorla et al. and Fitzpatrick et al., whether taken alone or in combination, fail to teach or suggest all of the features of

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dependent claim 5. Accordingly, Applicant respectfully submits that dependent claim 5 patentably distinguishes over the prior art and is, therefore, in condition for allowance.

Applicant also respectfully submits that there is a lack of motivation to combine the teachings of Fitzpatrick et al. with Cassorla et al. Fitzpatrick et al. is directed towards multiple windows in graphical user interfaces (GUI). Cassorla et al., on the other hand, is directed towards an electronic marking system for electronic documents that reside in one window. Applicant respectfully submits that there is no motivation to combine a technology directed toward multiple windows in a GUI operating system with an invention that is directed to only one window, a document.

Accordingly, favorable reconsideration and withdrawal of the rejection of dependent claim 5 is respectfully requested.

Conclusion

Applicant believes that the present Amendment is responsive to each of the points raised by the Examiner in the Office Action. However, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

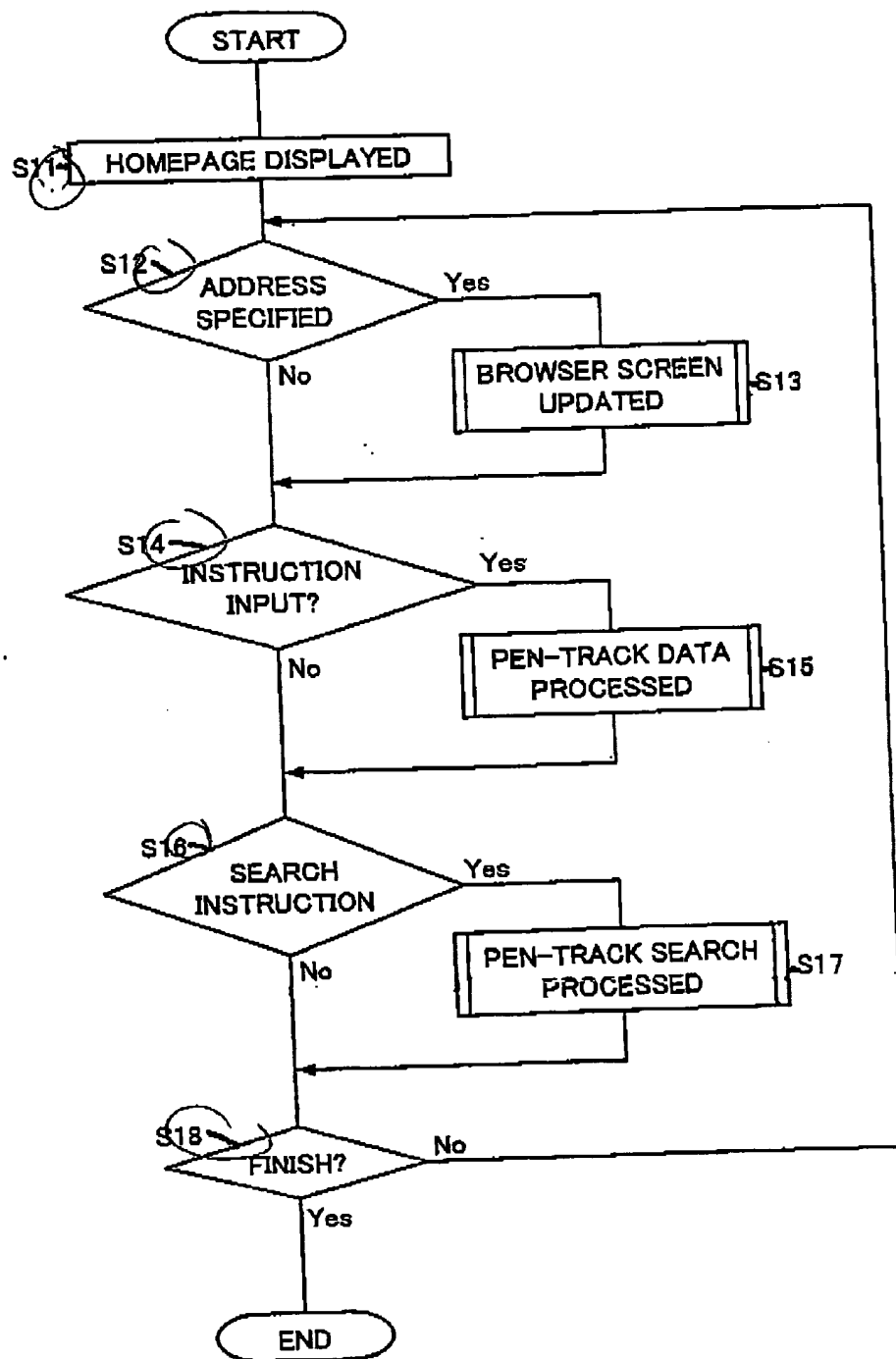
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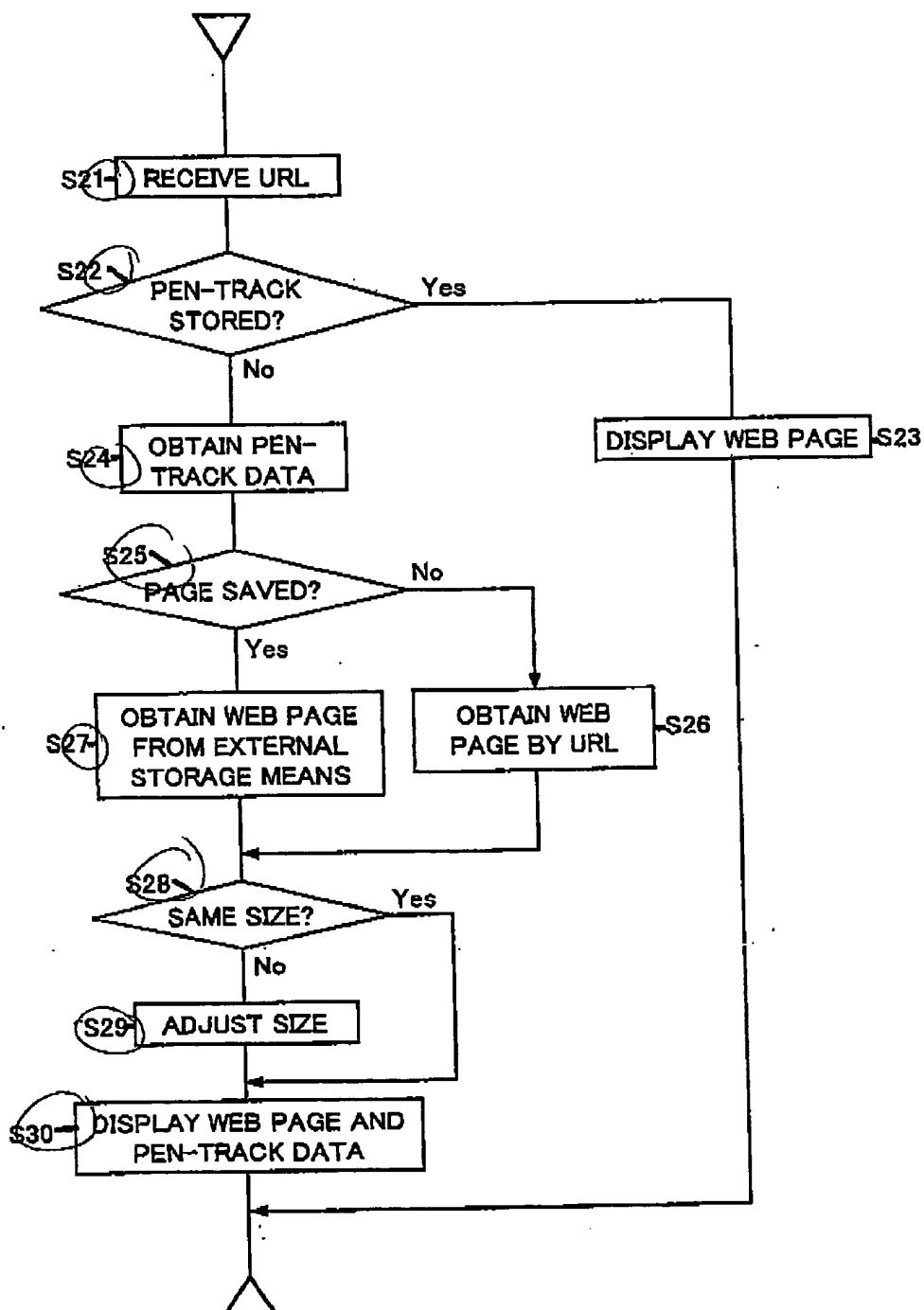
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Allison Olenginski
Registration No. 55,509

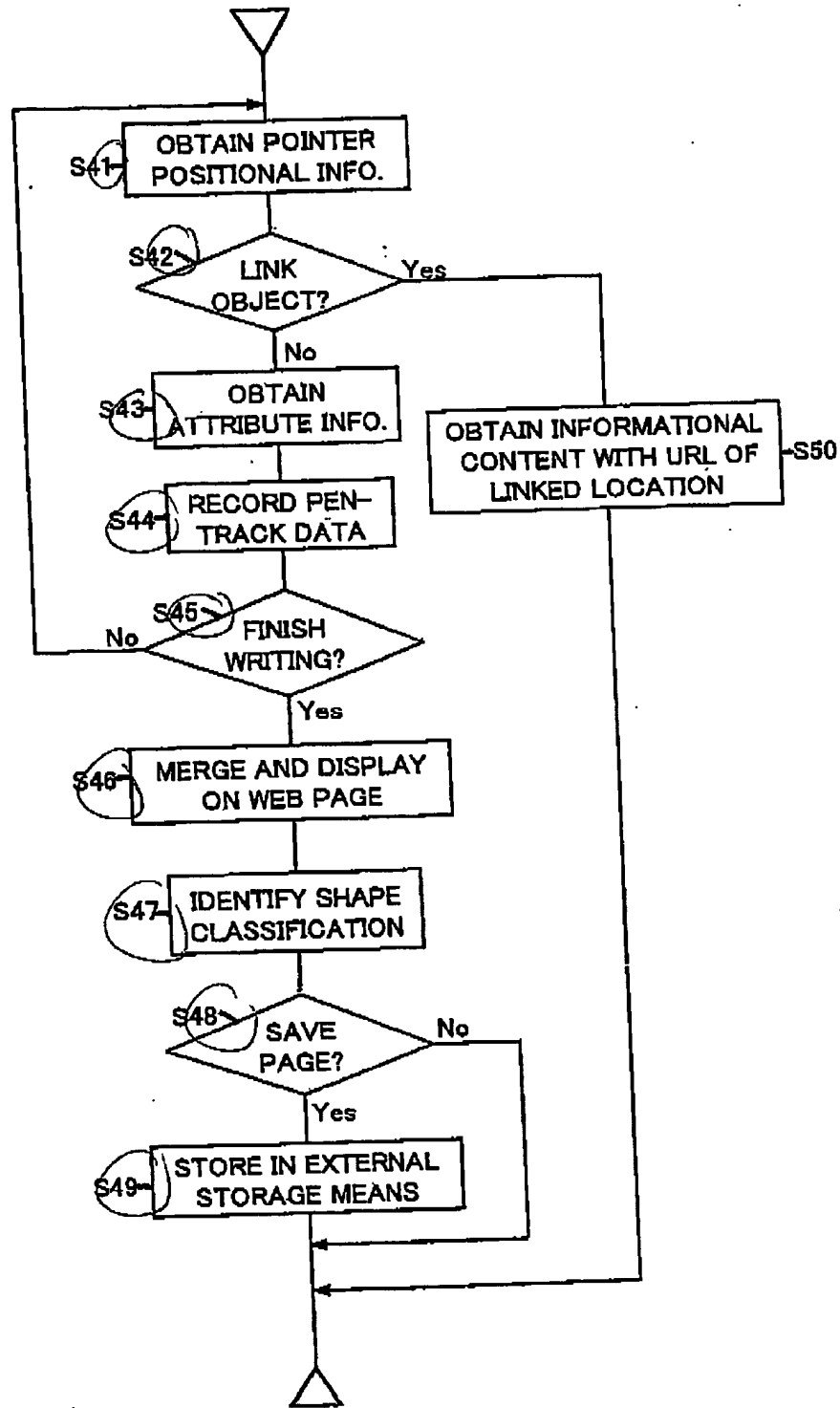
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On June 14, 2006
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By: [Signature]
Date: June 14, 2006

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SERIAL NO.: 10287, 617
DOCKET NO.: 1405, 1077
Figure 2 - Marked Up Sheet

*Fig. 2*

*Fig. 3*

**Fig. 4**

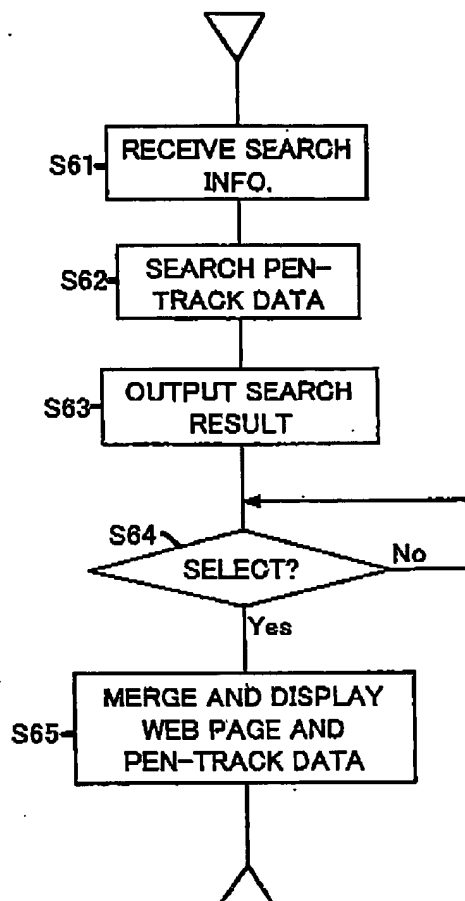


Fig. 5